

In re Patent Application of:

**ROBERT M. HERRIN**

Serial No. **10/721,962**

Filing Date: **11/25/2003**

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**Remarks**

Applicant and the undersigned would like to thank the Examiner for his efforts in the examination of this application. Claims 1-19 remain in the case. Originally filed Claims 20-45 are withdrawn as a result of the restriction being maintained by the Examiner. Claims 1-6, 8, 10, 11, 12-16, 18, and 19 were rejected under 35 USC §102(b) as being anticipated by US Patent No. 5,971,906 to Tharpe, Jr. et al. Claims 7, 9, and 17 were rejected under 35 USC §103(a) as being unpatentable over Tharpe '906 in light of "official notice" taken by the Examiner.

**Improper Rejection Under 35 USC §102**

Respectfully, Applicant and the undersigned traverse the rejection under 35 USC §102(b) as being improper for failing to contain every element and limitation recited in the claims. With regard to independent Claim 1, all elements of the claim are not disclosed in the Tharpe '906 reference. By way of example, Tharpe '906 does not include a first folding arm (120) movably positioned for biasing against an extended portion of the partially formed tray as called for in Claim 1. As described in Col 6, beginning Line 64. Tharpe '906 teaches folding arms (218) positioned for cooperating with the platen (212) in receiving the blank, and as illustrated with reference to FIG. 11 of the reference, are fixed for cooperating with the movable platen. Further, Tharpe '906 does not include "a second folding arm 412 for biasing against the portion of the formed tray through the passage" as specified by the Examiner.

While the Applicant and the undersigned understand that the examiner may take the broadest interpretation of language in a claim, it is argued that while the Examiner interprets a "passage" being formed between the fixed plate (clamp 420 of Tharpe '906) and the compression plate (426), the second folding arm (128) of the claimed invention and the second folding arm (412) of Tharpe '906 (as identified by the Examiner) does

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not fold the extended portion through the "passage" defined by the Examiner.

The Examiner has identified the forming rails (210) and first folding arm (218) as separate elements, a teaching that is contrary to that of the Tharpe '906 reference which describes such elements as being part of the folding guide arms (218).

With regard to Claim 8, depending from Claim 1, Tharpe '906 (as illustrated by way of example with reference to FIG. 1) does not disclose nor suggest a guide plate (158) carried by the platen (102) for providing a compression surface (160), as illustrated by way of example with reference to FIG. 9 and Paragraph 34, as originally described in the specification.

Applicant respectfully requests a retraction of the rejection under 35 USC §102(b) for Claims 1-6, 8, 10, 11, 12-16, 18, and 19, and the rejection of Claims 7, 9, and 17 under 35 USC §103(a).

### **Non-Enabling Disclosure of Cited Reference**

The Tharpe '906 reference is non-enabling. A reference must sufficiently describe the claimed invention to have placed the public in possession of it (see *Paperless Accounting, Inc. v. Bay area Rapid Transit Systems*, 804 F.2d 659, 665, 231 USPQ 649, 653 (Fed. Cir. 1986)). By way of supporting example, Tharpe '906 does not provide an enabling disclosure for forming the "double glued wall construction" as described in the specification of the Applicant with reference to FIG. 19, as does the claimed invention. While the Examiner may choose to assign an element of Tharpe '906 to an element of the claimed invention, it is only through the teachings of the Applicant that such a selection may be made, and even when made does not form the claimed invention.

Applicant respectfully submits that the above remarks place this application in a condition for allowance, and passage to issue is respectfully solicited. The Applicant

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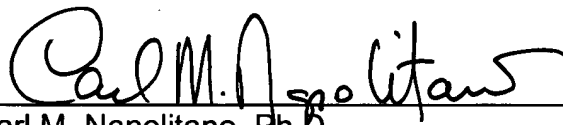
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and the undersigned would like to again thank the Examiner for his efforts in the examination of this application and for reconsideration of the claims in light of the arguments presented. If the further prosecution of the application can be facilitated through telephone interview between the Examiner and the undersigned, the Examiner is requested to telephone the undersigned at the Examiner's convenience.

Respectfully submitted,



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Carl M. Napolitano, Ph.D.

Reg. No. 37,405

ALLEN, DYER, DOPPELT, MILBRATH & GILCHRIST, P.A.

255 South Orange Avenue, Suite 1401

P.O. Box 3791

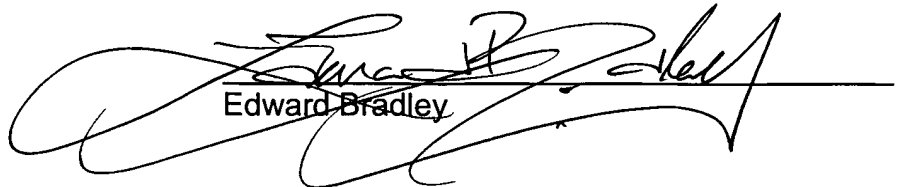
Orlando, Florida 32802

(407) 841-2330

Agent for Applicant

#### **CERTIFICATE OF MAILING**

I hereby certify that the foregoing is being deposited with the United States Postal Service as first class mail in an envelope addressed to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, this 1<sup>st</sup> day of June, 2005.



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Edward Bradley